

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN RE APPLICATION OF:

ANDREAS ARNING

SERIAL NO.: 10/034,973

FILED: 20 DECEMBER 2001

**FOR: SYSTEM AND METHOD FOR
REWARDING A USER'S
INTERACTION BEHAVIOR
WITH A COMPUTER
SYSTEM**

ATTY. DOCKET NO.: DE920000058US1

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EXAMINER: VAN BRAMER, JOHN W.

CONFIRMATION NO. 2103

ART UNIT: 3622

SUBSTITUTE APPEAL BRIEF UNDER 37 C.F.R. 41.37

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Substitute Appeal Brief is submitted in support of the Appeal of the Examiner's final rejection of Claims 1-24 in the above-identified application. A Notice of Appeal was filed in this case on July 20, 2006 and received in the United States Patent and Trademark Office on July 20, 2006. An original appeal brief was filed on August 25, 2006.

This substitute appeal brief is filed in response to a December 1, 2006 Notification of Non-Compliant Appeal Brief, for failing to identify the location of support in the specification for the claimed "means for starting a timer" and "means for stopping a timer" recited in Claim 2. This support was stated in the summary of the invention of the original appeal brief, but not in the arguments. Appellants apologize for the oversight.

Appellants do not believe that any additional fees are due for filing this substitute appeal brief. In the event that such fees are due, please charge such fees, as well as any additional required fees, to **IBM CORPORATION DEPOSIT ACCOUNT No. 09-0461**.

REAL PARTY IN INTEREST

The real party in interest in the present Application is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment set forth at reel 012615, frame 0038.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, the Appellants' legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-24 stand finally rejected by the Examiner as noted in the Final Office Action dated April 20, 2006. The rejection of Claims 1, 2, 10, 11 and 20 under 35 U.S.C. § 102(e) are appealed.

STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the April 20, 2006 Final Office Action from which this Appeal is filed.

SUMMARY OF THE CLAIMED SUBJECT MATTER

As recited by Appellants' independent **Claims 1 and 10**, Appellants' invention provides a system and computer readable code loaded in memory for providing a reward to an Internet user who visits a second website from a first website. Specifically, as recited in exemplary Claim 1 (which recites "means" that are supported in U.S. Patent Application Publication No. 2003/0120542 A1 (the present application) at paragraph [0025] and Figures 1-2), the invention includes loading a first document from a first server over the internet onto a network access device of the user in response to a user request to download the first document received at the first server over the computer network, the first document having a hyperlink to a second document on a second server connected to the computer network (as supported by Figure 3 at block 1, and in the written specification at paragraph [0048]); determining whether said user

selects the hyperlink and navigates to receive said second document over the computer network from the second sewer (supported by Figure 3 at block 2, and in paragraph [0050]); determining whether said user returns to said first document (supported by Figure 3 at block 3, and in paragraph [0049]); and providing a reward to said user in response to said user returning to said first document (supported by Figure 3 at block 4, and in paragraph [0049]).

As described in dependent **Claims 2, 11 and 20**, in order to ensure that the user actually looks at the second document, the user may receive the reward only if the user spends more than a minimum amount of time and less than a maximum amount of time at the second document, as supported in paragraph [0057] of U.S. Patent Application Publication No. 2003/0120542 A1 (the present application), and blocks 47-50 of Figure 4. Note that exemplary **Claim 2** also claims “means for starting a timer” and “means for stopping a timer.” These features are supported at paragraph [0025] (“The present invention can be realized in hardware...adapted for carrying out the method described herein”) and Figures 1-2 (which depict in an exemplary manner such hardware). The feature of starting and stopping a timer are inherent in paragraph [0057], in which a specific “amount of time” is measured. The feature of using a “timer” to measure this time is supported in the originally filed Claim 2.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- A. The Examiner’s rejection of Claims 2, 11 and 20 under 35 U.S.C. § 102(e) as being anticipated by *Lowell* (U.S. Patent No. 6,381,632 – “*Lowell*”) is to be reviewed on Appeal.
- B. The Examiner’s rejection of Claims 1 and 10 under 35 U.S.C. § 102(e) as being anticipated by *Lowell* (U.S. Patent No. 6,381,632 – “*Lowell*”) is to be reviewed on Appeal.

ARGUMENTS

- A. The Examiner's rejection of Claims 2, 11 and 20 under 35 U.S.C. § 102(e) as being anticipated by *Lowell* (U.S. Patent No. 6,381,632 – "*Lowell*").

The Examiner's rejection of Claims 2, 11 and 20 is improper since the cited prior art does not teach or suggest all of the limitations of the claims.

Lowell is primarily directed to a method and system for monitoring activities on a website by a computer (*Lowell abstract*). Examples of such activities include "connect, disconnect, browse, accessing areas within a network site, uploading and/or downloading data, ordering products, participating in surveys, and participation in real-time and/or on-line events." (*Lowell*, col. 5, lines 7-10).

It is axiomatic that to support a rejection based on anticipation, the cited art must teach or suggest every element of the rejected claim. (*MPEP* § 2131.)

With regards to exemplary Claim 2, the cited art does not teach or suggest "providing a reward to said user in response to the user returning to the first web document from the second web document," as claimed in base Claim 1 as and supported by Figure 3 at block 3, and in paragraph [0049] of U.S. Patent Application Publication No. 2003/0120542 A1 (the present application), such that "the reward is provided to the user only if the timer value is greater than the first threshold value and smaller than the second threshold value," as supported by the originally filed claims and in paragraph [0057] of U.S. Patent Application Publication No. 2003/0120542 A1.

Note that exemplary **Claim 2** also claims "means for starting a timer" and "means for stopping a timer." These features are supported at paragraph [0025] ("The present invention can be realized in hardware...adapted for carrying out the method described herein") and Figures 1-2 (which depict in an exemplary manner such hardware). The feature of starting and stopping a timer are inherent in paragraph [0057], in which a specific "amount of time" is measured. The

feature of using a “timer” to measure this time is supported in the originally filed Claim 2.

As described in paragraph [0011] of U.S. Patent Application Publication No. 2003/0120542 A1 (the present application), the present invention provides “an incentive...to a user who follows a hyperlink in a first document to a second document and then intentionally returns to the original document.” As supported at paragraphs [0055] and [0056], the user may receive his reward (e.g., bonus points – see paragraph [0046]) only if the user goes to the second website for at least a minimum amount of time, but does not stay at the second website beyond a maximum amount of time.

Without this claimed and properly supported feature, a user could go to a second website and back to the first website without ever reading the second website (by not staying the minimum amount of time). Alternatively, the user may “camp out” on the second website (by staying longer than the maximum amount of time), such that the first website loses his patronage. To prevent either condition, the user will get his reward through the first website only if he stays at the second website for a prescribed period of time (not too brief; not too long). Appellants do not dispute that *Lowell* teaches that an activity can be timestamped. However, this does not teach (expressly or implicitly) or suggest that a user must stay at the second website for a prescribed period of time to get a reward (“the reward is provided to the user only if the timer value is greater than the first threshold value and smaller than the second threshold value,” as supported by the claims as originally filed and at paragraphs [0055] and [0056].

Appellants further note that, at page 15 of the Final Office Action, the Examiner “has interpreted the upper threshold to be a real number approaching infinity.” Such an interpretation would teach away from the presently claimed invention since the user could never return to the first website if he had to wait a nearly infinite amount of time to do so.

As the cited art does not teach or suggest all of the limitations of the presently claimed invention, this rejection is not well founded and should be reversed.

- B. The Examiner's rejection of Claims 1 and 10 under 35 U.S.C. § 102(e) as being anticipated by *Lowell* (U.S. Patent No. 6,381,632 – "*Lowell*").

The Examiner's rejection of Claims 1 and 10 is improper since the cited prior art does not teach or suggest all of the limitations of the claims.

With regards to exemplary Claim 1, the cited art does not teach (expressly or implicitly) or suggest "providing a reward to said user in response to the user returning to the first web document from the second web document," as supported by the originally filed claims and by Figure 3 at block 4, and in paragraph [0049] of U.S. Patent Application Publication No. 2003/0120542 A1 (the present application).

Appellants do not dispute the Examiner's contention on page 14 of the Final Office Action that *Lowell* teaches that a user may connect to, disconnect from, or browse a website. Appellants do not dispute that such activities may be monitored (*Lowell*, Col. 4, line 62 – Col. 5, line 12). However, there is no teaching or suggestion that in order for a user to get a reward, that user must return to the original website. That is, there is no teaching or suggestion of "providing a reward to said user in response to the user returning to the first web document from the second web document," as supported by the claims as originally filed.

Lowell never describes a user going from a first website to a second website, and then back to the first website. Even if *Lowell* were to describe such a condition, there is no teaching or suggestion that the provision of a reward to the user is predicated on ("in response to") the user returning to the first website.

As the cited art does not teach or suggest all of the limitations of the presently claimed invention, this rejection is not well founded and should be reversed.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language which renders the invention patentable over the various combinations of references. Appellants, therefore, respectfully request that this case be remanded to the Examiner with instructions to issue a Notice of Allowance for all pending claims.

Respectfully submitted,



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CLAIMS APPENDIX

1. In a computing environment, a system for providing a reward to a user of the Internet for desired web site visiting behavior, said system comprising:

means located at a first server for loading a first web document over the Internet to a user's computer, said first web document having a hyperlink to a different server for a second web document;

means for monitoring at the first server whether said user selects said hyperlink to navigate to said second web document;

means at said first server responsive to a detection for monitoring whether said user returns to said first document; and

means at said first server for providing a reward to said user in response to the user returning to the first web document from the second web document.

2. The system of Claim 1, further comprising:

means for starting a timer in response to the user selecting the hyperlink in the first web document;

means for stopping the timer when the user returns to the first web document and determining a timer value; and

means for comparing the timer value to a first and a second threshold value, wherein, the reward is provided to the user only if the timer value is greater than the first threshold value and smaller than the second threshold value.

3. The system of Claim 1, wherein the user accesses the first and second web documents on the user's computer which is a client computer, said system further comprising:

means for storing a client computer system time in response to the user selecting the hyperlink; and

means for calculating a time value for time spent at the second web document by comparing a current client computer system time to the stored client computer system time when the user returns to the first web document, wherein the reward is provided to the user only if the time value is greater than a first threshold value and smaller than a second threshold value.

4. The system of Claim 3, wherein said means for providing the reward to the user further comprising means for providing positively priced information to the client computer.

5. The system of Claim 3, wherein the first web document is associated with a server computer and said means for providing the reward further comprises:

means for storing unique user identification data on the client computer;

means for storing user information required to reward the user on the server computer, the user information being retrievable based on the unique user identification data; and

music file;

means for providing the unique user identification data to the server computer in response to the user returning to the first web document for retrieval of the user information to effect the reward.

6. The system of Claim 1, further comprising means for loading program data to the users computer concurrently with the loading of the first web document, the program data being executable for monitoring the user selecting the hyperlink and returning to the first document and for requesting the reward when the user returns to the first web document.

7. The system of Claim 2, wherein said first threshold value is a time period necessary for a human user to perceive information provided by the second web document.

8. The system according to Claim 1, wherein said reward comprises one or more elements from the set of:

further information;

a video file;

a software product;

access to an electronic service;

bonus points usable within an e-commerce business; and

a cash payment.

9. The system according to Claim 1, further comprising:
means for administrating statistical information after said user returns to said first web document to measure attractiveness of said second web document due to its accessibility through said hyperlink from said first web document.
10. Computer readable code loaded memory for execution on a computer, for providing a reward to a user of the Internet for desired web site visiting behavior, said code comprising:
first subprocesses for loading a first web document from a first server over the internet to a user's computer, said first web document having a hyperlink to a second web document located at a second server connected by the internet to the user's computer and the first server;
second subprocesses for monitoring whether said user selects the hyperlink to navigate to said second web document;
third subprocesses for monitoring whether said user returns to receive said fast document from said first server; and
fourth subprocesses for providing a reward to said user over the internet from the first server in response to the user returning to the first web document from the second web document.
11. Computer readable code according to Claim 10, further comprising:
fifth subprocesses for starting a timer in response to the user selecting the hyperlink in the first web document;
sixth subprocesses for stopping the timer when the user returns to the first web document and determining a timer value; and
seventh subprocesses for comparing the timer value to a first and a second, threshold value, wherein the reward is provided to the user only if the timer value is greater than the first threshold value and smaller than the second threshold value.
12. Computer readable code according to Claim 10, wherein the user accesses the first and second web documents on the user's computer which is a client computer, said code further comprising:

eighth subprocesses for storing a client computer system time in response to the user selecting the hyperlink; and

ninth subprocesses for calculating a time value for time spent at the second web document by comparing a current client computer system time to the stored client computer system time when the user returns to the first web document, wherein the reward is provided to the user only if the time value is greater than a first threshold value and smaller than a second threshold value.

13. Computer readable code according to Claim 12, wherein said fourth subprocesses further comprises providing positively priced information to the client computer.

14. Computer readable code according to Claim 12, wherein the first web document is associated with a server computer and said fourth subprocesses further comprises:

tenth subprocesses for storing unique user identification data on the client computer;

eleventh subprocesses for storing user information required to reward the user on the server computer, the user information being retrievable based on the unique user identification data; and

twelfth subprocesses for providing the unique user identification data to the server computer in response to the user returning to the first web document for retrieval of the user information to effect the reward.

15. Computer readable code according to Claim 10, further comprising thirteenth subprocesses for loading program data to the user's computer concurrently with the loading of the first web document, the program data being executable for monitoring the user selecting the hyperlink and returning to the first document and for requesting the reward when the user returns to the first web document.

16. Computer readable code according to Claim 11, wherein said first threshold value is a time period necessary for a human user to perceive information provided by the second web document.

17. Computer readable code according to Claim 16, wherein said reward comprises one or more elements from the set of:

- further information;
- a music
- a video file;
- a software product;
- access to an electronic service;
- bonus points usable within an e-commerce business; and
- a cash payment.

18. Computer readable code according to Claim 10, further comprising:

fourteenth subprocesses for administrating statistical information, after said user returns to said first web document to measure attractiveness of said second web document due to its accessibility through said hyperlink from said first web document.

19. A computerized method to provide a reward to a user interacting with a computer network, said method comprising the steps of:

loading a first document from a first server over the internet onto a network access device of the user in response to a user request to download the first document received at the first server over the computer network, the first document having a hyperlink to a second document on a second server connected to the computer network;

determining whether said user selects the hyperlink and navigates to receive said second document over the computer network from the second server;

determining whether said user returns to said first document; and

providing a reward to said user after said user returns to said first document.

20. The computerized method of Claim 19, further comprising the steps of:

if it is determined that the user has returned to the first document, determining an amount of time for the user spent by the user before returning to the first document; and

comparing the amount of time to a first threshold value and a second threshold value; and

providing the reward only if the amount of time is greater than the first threshold value and smaller than the second threshold value.

21. The computerized method of Claim 19, wherein the user accesses at least one server computer associated with the computer network using the network access device, said method further comprising the steps of:

- storing unique user identification data on the network access, device;

- storing user information required to reward the user by said first server computer, the user information being retrievable based on the unique user identification data; and

- providing the unique truer identification data to the server computer in response to the user returning to the first document for retrieval of the user information to effect the reward.

22. The computerized method according to Claim 20, wherein said first threshold is a time period necessary for a human user to perceive information provided by the second document.

23. The computerized method according to anyone of Claim 19, wherein said reward comprises one or more elements from the set of:

- further information;

- a music file;

- a video file;

- a software product;

- access to an electronic service;

- bonus points usable within an e-commerce business; and

- a cash payment.

24. The computerized method according to Claim 19, further comprising the step of:

- administrating statistical information after said user returns to said first document to measure attractiveness of said second document due to its accessibility through said hyperlink from said first document.

EVIDENCE APPENDIX

Other than the Office Action(s) and reply(ies) already of record, no additional evidence has been entered by Appellants or the Examiner in the above-identified application which is relevant to this appeal.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings as described by 37 C.F.R. §41.37(c)(1)(x) known to Appellants, Appellants' legal representative, or assignee.